

REMARKS

Claims 1, 2 and 4 are amended herein. Claims 1-18 are pending and under consideration.

The rejections based on Lee are respectfully traversed. Using independent claim 8 as an example, this claim recites a guide disposed between first and second guide positions to respectively stack the discharged papers in first and second stacking positions, the first and second stacking positions being disposed so that trailing edges of the papers are disposed relative to each other along the discharge direction.

The Examiner does not assert that Lee discloses the trailing edges being disposed relative to each other along the discharge direction. Instead, the Examiner states that this limitation does not add any additional structure. It is respectfully submitted that the Examiner must consider the limitation, even assuming, *arguendo*, that the limitation does not provide any additional structure.

There is nothing intrinsically wrong with the use of functional claim language. *In re Swinehart and Sfiligoj*, 169 USPQ 226 at 228. However, where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on. *Id.* at 229.

It can be inferred from *In re Swinehart and Sfiligoj* that functional distinctions can distinguish over the prior art, provided that the applicant can prove the prior art does not possess the relied-upon feature. Figs. 2 and 4 of Lee illustrate the papers in the stacker 10 in a single position. Thus, it is submitted that this reference does not possess the claimed feature of the trailing edges being disposed relative to each other along the discharge direction.

Claim 6 recites the guide panel moves to the first position by pivotingly falling from the second position due to a weight thereof, when the driving unit is turned off. The Examiner relies upon Fig. 2a of Toyoki. However, this figure is a top view, and therefore illustrates that the guide 7 moves horizontally. As shown in Fig. 3 of the reference, this movement is due to a spring 9, not due to a weight thereof.

Masaru does not overcome these deficiencies in Lee and Toyoki, and is not relied on by the Examiner to do so.

Accordingly, withdrawal of the rejections is requested.

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

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9-13-06

By: _____

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